

- II. Claims 1-3 and 8, drawn to a trimming device with a specific cutter assembly configuration; or
- III. Claims 1 and 4-6, drawn to a trimming device with a specific control structure.

The Examiner contends that the patentability of the invention is presumed to lie in the details of the particular group (e.g., the specific feed roller configuration of Group I). The Examiner further contends that the inventions are distinct because the invention of Group I does not require the specific details of the invention of Group II and vice versa. The Examiner contends the same with regard to Groups I and III, and Groups II and III. The Examiner argues that because the inventions are distinct for the above reasons and have acquired a separate status in the art as shown by their different classification, and have acquired separate status in the art because of their recognized divergent subject matter, restriction for examination purposes is proper. Applicant respectfully traverses this restriction requirement.

As a preliminary matter, it appears that the Examiner has incorrectly grouped the claims of Groups I and II. Group I is directed to a trimming device with a specific feed roller configuration and therefore should include claims 1, 3 and 7. Group II is directed to a trimming device with a specific cutting assembly configuration and therefore should include claims 1, 2 and 8.

For restriction under 35 U.S.C. § 121 to be proper, the restriction must comply with M.P.E.P. § 808, which requires that the Examiner provide (1) reasons why the inventions are independent or distinct, and (2) reasons for insisting on restriction. The Examiner has alleged that the present application claims more than one distinct invention. Whether an invention is distinct is governed by M.P.E.P. § 806, and in particular, M.P.E.P. § 806.05(c)-(i). The

Examiner has alleged (albeit implicitly) that distinctiveness of the claims of the above-captioned application are governed by M.P.E.P. § 806.05(c) (combination/subcombination) and Applicant agrees. Clearly M.P.E.P. §§ 806.05(d)-(i) are not applicable in the present circumstances as the Applicant does not claim separate subcombinations usable together (806.05(d)), a process and apparatus for its practice (806.05(e)), a process of making and product made (806.05(f)), an apparatus and product made (806.05(g)), a product and process of using (806.05(h)) or a product, process of making and process of using (8096.05(i)).

M.P.E.P. § 806.05(c) provides, in relevant part,”

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be established. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary. . .

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to shown novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The above-captioned application clearly recites both combination claims (claims 2-8) and a subcombination claim (claim 1). It is respectfully submitted that the Examiner has not shown that the combination, as claimed, “does not require the particulars of the subcombination as claimed for patentability” as required at subparagraph (A) of M.P.E.P. § 806.05(c). The Examiner has merely stated, incorrectly, that the inventions are distinct because the invention of one Group does not require the specific details of any other Group for patentability. In the present context, and as executed by the Examiner, this is a misapplication of 806.05(c), which requires comparison of the particulars of the combination as claimed with the subcombination as

claimed. See M.P.E.P. § 806.01 (“In passing on questions of . . . restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctiveness or independence.”) Rather than compare the combinations and subcombination “as claimed,” the Examiner has chosen only a particular element of the combinations for each of the arguments presented. For example, the Examiner has argued that the inventions of Groups I and II are distinct because the invention of Group I does not require the specific details of the cutter assembly configuration of Group II for patentability as evidenced by the omission thereof from Group I. The Examiner fails to recognize that the inventions of Groups I and II, as claimed, depend from the same subcombination claim and have three of four claims in common. Clearly the Examiner has not compared the combination/subcombination “as claimed,” but rather has compared one combination with one particular feature of another combination. Viewed in this light, virtually any application having dependent claims would be a proper candidate for a restriction requirement. The Examiner has taken the same improper strategy with regard to comparison of Groups II and III, and Groups I and III.

Applicant respectfully directs the Examiner’s attention to Example II to M.P.E.P. § 806.05(c), which is believed to be directly on point with regard to the above-captioned application. Example II states as follows:

If there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}, restriction should not be required. Where the relationship between the claim is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination AB_{sp} as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

There clearly is no evidence that any combination claim (claims 2-8, i.e., AB_{sp}) of the above-captioned application is patentable without the details of the subcombination claim (claim 1, i.e., B_{sp}). This is evidenced not only by the fact that each combination claim depends from a single subcombination claim, but that each of the combination claims recites only a feature of the subcombination. For example, claim 2 (a combination claim) recites, *inter alia*, pivotal mounting of the cutting assembly, whereas the cutting assembly *per se* is recited in claim 1 (the subcombination claim) along with the other elements of the subcombination. The same can be argued with respect to each of the combination claims. For the above-discussed reasons, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Additionally with regard to the restriction requirement, M.P.E.P. § 806.05(c) requires that for claims directed to a combination and subcombination to be distinct, the combination and subcombination, each as claimed, must have separate utility. “The burden is on the examiner to suggest an example of separate utility.” *Id.* The Examiner has not suggested an example of separate utility as between the combination and subcombination. Accordingly, and independently of the above discussion, the Examiner’s restriction requirement is improper. Reconsideration and removal of the restriction requirement are respectfully requested.

35 U.S.C. § 121

(Election Of Species)

The Examiner has also required that Applicant elect between Species A, directed to the pivoted cutter assembly as shown in Figure 1, and Species B, directed to the pivoted feed rollers disclosed but not shown. Applicant respectfully traverses this election requirement. Inasmuch as all the claims depend from claim 1, there is no additional burden on the Examiner to examine all claims to Species A and B, particularly as Species A and B are within the same art.